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In re Application of:
ARDELEANU et al.
Application No. 09/599,813
Filed: June 21, 2000
Docket No.: MSI-583US

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OFFICE OF PETITIONS

The above-identified application has been referred to this office to treat the petition to expunge under 37 CFR 1.59 filed May 2, 2005, which under the circumstances of this case is more properly treated as a petition under 37 CFR 1.182 to disregard the reply filed April 11, 2005, in favor of the reply filed May 2, 2005.

The petition is **granted** to the extent indicated below.

A final office action was mailed February 8, 2005, which set an extendible 3 month period for reply and contained *inter alia*, a rejection of all claims which relied upon a certain U.S. patent application publication ("publication").

On April 11, 2005, applicant filed a RCE and a submission which, in essence, relied upon a declaration under 37 CFR 1.131 to antedate the publication as a means of replying to the rejection.

On May 2, 2005, which is still within the original period for reply to the outstanding Office action, in addition to the instant petition, applicant also filed a reply which traversed the rejection on the merits as opposed to relying on the aforementioned declaration as the means of replying to the rejection.

Petitioner wishes to have the USPTO consider the later reply to the exclusion of the previous reply, while reserving his option of later relying upon antedation, if necessary, to overcome the rejection. Petitioner also requests that the previous reply containing the declaration under 37 CFR 1.131 be expunged and returned.

As to the rule governing this case, 37 CFR 1.59 provides that, upon a showing satisfactory to the Director, information, other than that forming part of the original disclosure may be expunged from an application. However, as indicated in MPEP 724.05 subsection II, this is more properly directed to information that was unintentionally submitted in a file. Inspection of the communication in question reveals

that it clearly was intentionally submitted in this file. Moreover, the USPTO has a long policy, which predates and continues beyond the current amendment of 37 CFR 1.59, of treating requests, as here, to disregard a communication such as e.g., a now unwanted or flawed terminal disclaimer (see MPEP § 1490(A)), or not further process a communication such as e.g., an unwanted CPA (see MPEP 201.06(d) subsection(II)(A)), as a petition under 37 CFR 1.182.

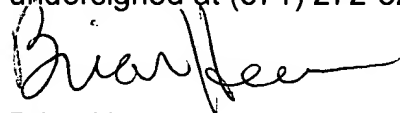
Since the reply filed April 11, 2005, will no longer be utilized, and the reply filed May 2, 2005, that will be utilized were both filed within the period for response, there is no question of abandonment if the former reply is withdrawn. Further, the examiner has not yet issued an Office action based on either reply. Accordingly, the request relief can be favorably considered to the extent that the later reply will be accepted and used for further examination.

In a paper file the former reply could, but not necessarily would, have been physically removed from the file wrapper and returned to applicant; in the IFW realm the corresponding action(s) is to close the document and also remove such from the listing of "Public[ly available] Documents." It is agreed that it would be appropriate in this instance to close the reply filed April 11, 2005, and also remove such from the listing of publicly available documents for this Image File Wrapper (IFW).

As a condition of this favorable treatment petitioner is required to maintain the material in question during the enforceable life of any patent arising from this application, or any patent claiming benefit of this application.

This application is being referred to the TC to consider the RCE and the reply filed May 2, 2005, in due course.

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for
Patent Examination Policy